

Remarks

Upon entry of this response, claims 1-21 and 23-28 will be pending in this application. Claim 22 has been canceled. New claims 29-44 have been added to the application.

Claim 1 has been amended to include the "third generation data capabilities" limitation that was found in original claim 2. Accordingly, amended claim 1 now recites "...including information in the preferred roaming list about the third generation data capabilities of each network..."

Claim 2 has been amended to reflect the incorporation of the "third generation data capabilities" limitation into claim 1. In other words, the limitation "...wherein said data capabilities includes information about whether each said network in said list of networks supports third generation data capabilities..." has been deleted from amended claim 2.

Claims 3 and 23 have been amended to recite that the preferred roaming list includes information about the network's data roaming support.

Claims 4 and 24 have been amended to recite that the preferred roaming list includes information about the network's ability to support IP mobile services.

Claims 5 and 25 have been amended to recite that the preferred roaming list includes information about the network's ability to support always-on features.

Similar to claim 1, claim 21 has been amended to recite that the mobile data device contains a preferred roaming list that includes information regarding the "third generation data capability" of each network found in the roaming list. This limitation was originally located in original claim 22. Accordingly, claim 22 has been canceled.

Since there is support for these amendments in the claims as well as in the specification (pg 3, line 9, to pg 4, lines 29; pg 5, line 10, to pg 13, line 12) as originally filed, no new matter is presented.

Support for new claims 29-44 can also be found throughout the specification as originally filed (pg 3, line 10, to pg 13, line 12). Therefore, no new matter is presented in connection with new claims 29-44.

Reconsideration of the initial rejection of claims 1-21 and 23-28 and allowance of these claims, as well as new claims 29-44, are respectfully requested on the basis of the following remarks.

Summary of Rejections and Objections

Claims 1-10, 11-19, 20, 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges et al. (WO 99/45723, hereinafter referred to as Bridges) in view of Guilford et al. (US 2002/0087674, hereinafter referred to as Guilford). Claims 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Guilford.

Rejection of Claims 1-10, 11-19, 20, 21-26 under 35 U.S.C. 103(a)

In section 2 of the Office Action dated October 13, 2005, the Examiner rejected claims 1-10, 11-19, 20, 21-26 under 35 U.S.C. 103(a) as being unpatentable over Bridges in view of Guilford.

The three prong test required for finding a *prima facie* case of obviousness under 35 U.S.C. 103(a) is well established under the Patent Laws of the United States. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 8th Edition, Incorporating Revision No. 3, §2142.

The present invention relates to a system and method wherein a mobile data device is provided with a preferred roaming list that includes information indicating whether each network in the list (e.g. a 3G network) supports 3G data capabilities (as opposed to, for example, 3G voice capabilities). This is advantageous because not all 3G networks are capable of supporting data services and by including information regarding the 3G data capabilities of the network in the preferred roaming list the battery life of the mobile data device is prolonged or preserved since the mobile data device will not attempt to access a 3G network lacking 3G data capabilities when 3G data capabilities are needed.

Thus, independent claim 1, as amended, recites:

... including information in the preferred roaming list about the third generation data capabilities of each network and determining preferred networks based on information within said preferred roaming list including geographic area and the third generation data capabilities of said network.

Independent claim 21, as amended, recites:

...said preferred roaming list including: identification information for each network within said list of networks; geographic information for each network within said list of networks; and information about each network within said list of networks indicating whether each network supports third generation data capability...

Similarly, Independent claim 11, as originally filed, recites:

...including information in the preferred roaming list about whether each said network in said list of networks supports third generation data capabilities; and determining preferred networks based on information within said preferred roaming list including a geographic area and whether said network supports third generation data capabilities...

Independent claim 20, as originally filed, recites:

...including in the preferred roaming list information about whether each said network in said list of networks supports third generation data capabilities...

Bridges discloses a mobile station that stores a list of preferred networks based on whether a particular network is a preferred wireless carrier in the roaming area that the mobile station is currently located. As acknowledged by the Examiner on page 4 of the Office Action, Bridges does not disclose a mobile data device having a preferred network list that includes information indicating whether each listed network supports 3G data capabilities.

The Examiner, however, argues that Guilford discloses intelligent network selection based on the third generation data capabilities of each network. Applicants respectfully disagree.

Guilford discloses a system wherein a wireless device is provided with a table that lists preferred networks to be used when roaming that, as shown in FIG. 4, may specify and group the networks based on whether each network is a second generation (2G) or a third generation (3G) network. Guilford does not disclose, however, also including data in the list that would indicate whether a particular 3G network actually supports 3G data capabilities. As noted above and in the specification of the present application, not all 3G networks support 3G data services. For instance, some 3G networks only support 3G voice services. As a result, in the system that is described

in Guilford, a user that needs 3G data capabilities may establish a connection with a 3G network that only supports 3G voice services and not 3G data services, in which case the user will have wasted the mobile data device's battery resources in establishing a connection to a network that does not provide the services that are needed.

In contrast, the present invention provides a system and method wherein a mobile data device is provided with a preferred roaming list that includes information indicating whether each network in the list (e.g. a 3G network) supports 3G data capabilities (as opposed to, for example, 3G voice capabilities). As stated above, this is advantageous because not all 3G networks are capable of supporting data services. By including information regarding the 3G data capabilities of each network in the preferred roaming list, the battery life of the mobile data device is prolonged or preserved since the mobile data device will not attempt to access a 3G network lacking 3G data capabilities when 3G data capabilities are needed.

Thus, the cited references do not teach, suggest, or disclose every limitation found in Applicants' claims 1, 11, 20, and 21 since they do not, alone or in combination, disclose a method or a system in which the mobile data device is programmed with a preferred roaming list that includes information regarding the 3G data capabilities of each network that is found within that list.

Additionally, it is well settled that to establish a prima case of obviousness, one must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references." Tec Air, Inc. v. Denso Manufacturing Michigan Inc., 192 F.3d 1353, 1359-1360 (Fed. Cir. 1999), quoting In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There is, however, "no suggestion to combine...if a reference

teaches away from its combination with another reference.” Id. At 1360. A reference teaches away from an invention “when a person of ordinary skill...would be led in a direction divergent from the path that was taken by the applicant.” Tec Air, 192 F.3d at 1360 (Fed. Cir. 1999), quoting In re Gurley, 27 F.2d 551, 553 (Fed. Cir. 1994). Guilford teaches a system where a mobile device will connect to a 3G network without knowing whether the network supports 3G data services. Thus, when 3G data services are needed, the system of Guilford may result in the connection to a 3G network that does not support 3G data services. As a result, Guilford clearly leads “in a direction divergent from the path that was taken by” the Applicants by teaching a system that does not take into account the 3G data capabilities of a network before connecting to that network. Accordingly, it is not proper to use Guilford to reject Applicants’ claims 1, 11, 20, and 21 under 35 U.S.C. §103(a).

Based on the above, Applicants respectfully submit that claims 1, 11, 20, and 21 are allowable over the cited references. In addition, because claims 2-10, 12-19, and 23-28 depend, either directly or indirectly, from one of claims 1, 11, 20, and 21, they are likewise believed to be allowable over the cited references.

Rejection of claims 27 and 28 under 35 U.S.C. 102(b)

In section 3 of the Office Action, the Examiner has rejected claims 27 and 28 under 35 U.S.C. 102(b) as being anticipated by Guilford.

MPEP §706.02(IV) clearly states that “...for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.”

Claim 27 recites:

...checking said new system against a PRL table to see if said new system supports third generation data capabilities; if said new system does not support third generation data capabilities, checking whether any system supports third generation data capabilities, and if so performing said starting and checking steps again; and if said new system does support third generation data capabilities, acquiring said new system.

As stated above, Guilford discloses a method and a system wherein a table of preferred networks is provided which may specify whether each network is a 2G or a 3G network. There is no explicit or implicit teaching in Guilford to include information in the preferred network list that indicates whether each 3G network actually supports 3G data services or to check whether the "new system" that is acquired by the mobile device supports 3G data capabilities. Accordingly, Applicants' submit that claims 27 and 28 are not anticipated by Guilford under 35 U.S.C. 102(b).

Conclusion

In light of the foregoing amendments and arguments, it is respectfully submitted that claims 1-21 and 23-28, as well as claims 29-44, are in proper form for issuance of a Notice of Allowance and such action is respectfully requested at an early date.

In the event that any outstanding matters remain with this application, examiner is invited to telephone the undersigned at 412-566-1920 to discuss such matters.

Respectfully submitted,


Robert A. Diaz
Attorney for Applicants